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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/735,397	12/12/2003	Reinhard Lihl	LVIP:109US	1695
7590	11/16/2005		EXAMINER ALIE, GHASSEM	
Simpson & Simpson, PLLC 5555 Main Street Williamsville, NY 14221			ART UNIT 3724	PAPER NUMBER
DATE MAILED: 11/16/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/735,397

Applicant(s)

LIHL ET AL.

Examiner

Ghassem Alie

Art Unit

3724

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) 9-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☒ Claim(s) 1 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 December 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 01/30/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Election/Restrictions

1. Applicant's election of Group I (claims 1-8) on 09/06/05 is acknowledged.

Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

2. Claims 9-16 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to nonelected inventions, there being no allowable generic or linking claim. The election was made **without traverse** on 09/06/05.

Drawings

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, a stepping motor with step counter and a servomotor as set forth in claim 5 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.
4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: "13" in Fig 4.

Corrected drawing sheets are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the

several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

5. Claim 1 is objected to because of the following informalities: "the knife and the specimen, the specimen," should be --the knife and the specimen,-- . See claim 1, lines 4-5. Appropriate correction is required.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Regarding claim 1, "the cutting device" lacks antecedent basis. Regarding claim 1, "transferring spacing to the cutting device" is also not clear. It should be noted that the spacing cannot be transferred. The data that represents the spacing between the specimen holder and the trimmed surface of the specimen can be transferred to the cutting device. However, the actual spacing is not transferable. Regarding claim 3, the phrase "the spacing is sensed during the motion of a milling cutter" is confusing. It should be noted that the spacing is measured with a trimming device as set forth in the independent

claim 1. Therefore, it is not clear whether the trimming device is actually a milling cutter or the milling cutter is actually the trimming device. Regarding claim 4, "wherein after trimming" is not clear. It should be noted that the step of trimming is not set forth in claim 1. In addition, "after trimming" is not clear. It is not clear what is being trimmed. It appears that claim 1 should recite, --after trimming the specimen by trimming apparatus--. Regarding claim 6, "the motion of milling cutter is sensed with a spindle drive, a stepping motor with step counter, and/or a servomotor" is not accurate. It should be noted that "a distance measuring system" senses the spacing between the trimmed surface of the specimen and the specimen holder. See page 8, lines 2-12 in the specification. The motion of milling cutter cannot be sensed by "a spindle drive, a stepping motor with step counter, and/or a servomotor." Regarding claim 8, "the zero mark is moved to upon activation of the cutting device" is not clear. It is not clear what moves toward the zero mark or where does the zero mark move with respect to the cutting device.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

a person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claim 1, 6, 8, and 10, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Gordon (5,533,342). Regarding claim 1, Gordon teaches a method of cutting a specimen having a trimmed surface with a cutter. It should be noted that the microtome or ultramicrotome has not been positively claimed. In addition, Gordon's device function as a microtome since, similar to a microtome, it cuts a thin portion of a specimen.

Gordon also teaches that the method include a step of providing a knife holder for the knife 20 and a specimen holder 22 for holding the specimen. Gordon also teaches a step of using a feed device for producing relative motion between the knife and the specimen. Gordon also teaches a step of ascertaining in a trimming apparatus the spacing between the trimmed surface of the specimen and the specimen holder. The freezing section, which is within a cutting apparatus, is defined as a trimming apparatus. The trimming apparatus measures the thickness t of the specimen, which is equivalent to the distance between the specimen holder and the trimmed surface of the specimen. Gordon also teaches steps of transferring the spacing data to the cutting device 20 and inserting the specimen holder into the cutting device. The specimen holder 22 is inserted into the cutting device by being transferred to the cutting device. See Figs. 1-1-4 and col. 5, lines 20-66 and col. 6, lines 1-66 in Gordon.

Regarding claim 2, Gordon teaches everything noted above including that the spacing between the trimmed the trimmed surface of the specimen and the holder is send in a trimming device.

Regarding claim 4, as best understood, Gordon teaches everything noted above including that after trimming the specimen is inserted together with the specimen holder 22 into the cutting device 20 and the specimen abuts against a stop. It should be noted that the specimen place on the specimen holder in the freezing section 18 has inherently trimmed surface, since it has been cut from a larger specimen. The specimen 12 abuts against a cylinder in the freezing section. The cylinder is defined as a stop. See Fig. 4 in Gordon.

Regarding claim 6, Gordon teaches everything noted above including that the trimming apparatus and the cutting device are coordinated with one another in a learning

mode. The first cut the first thickness of the specimen by cooperation of the freezing station and cutting station is considered to be a learning mode for cutting the next thickness of the specimen.

Regarding claim 7, Gordon teaches everything noted above including a step of setting a define spacing between the trimmed surface of the specimen and the knife in the cutting device and storing the defined spacing.

Regarding claim 8, Gordon teaches everything noted above including that the cutting device is equipped with travel measurement system that has zero mark and the zero mark moved to upon activation of the cutting device.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1-3, and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jefferson (4,426,179). Regarding claim 1, Jefferson teaches a method of cutting a specimen having a trimmed surface with a cutter. Jefferson also teaches that the method include a step of providing a knife holder for the knife 18 and a specimen holder 42 for holding the specimen. Jefferson also teaches a step of using a feed device for producing relative motion between the knife and the specimen. Jefferson also teaches a step of ascertaining in a trimming apparatus the spacing between the trimmed surface of the specimen and the specimen holder. The detector plate and vise 38 are located in an apparatus that trims a

specimen. Therefore, the detector plate and the vise 38 are part of a trimming apparatus which can be defined as a trimming apparatus. The trimming apparatus measures the distance between the trimmed surface 94b and the upper surface of the holding device 42. Jefferson also teaches steps of transferring the spacing data to the cutting device 18 and inserting the specimen holder into the cutting device. 1-9 and col. 3, lines 24-68 and col. 4, lines 1-56 in Jefferson. Jefferson does not teach that the cutting device is microtome. However, it should be noted that the microtome or ultramicrotome has not been positively claimed. In addition, Gordon's device is capable of cutting a specimen. It would have been obvious to a person of ordinary skill in the art to cut a thin thickness of a specimen with Jefferson's cutting device, since Jefferson's cutting device is capable of cutting a thin thickness of a specimen and function as a microtome.

Regarding claim 2, Jefferson teaches everything noted above including that the spacing between the trimmed the trimmed surface of the specimen and the holder is send in a trimming device.

Regarding claim 3, Jefferson teaches everything noted above including that the spacing is measured during a milling cutter. The cutting 18 is considered to be a milling cutter.

Regarding claim 5, Jefferson teaches everything noted above including that the motion of the milling cutter is inherently sensed by a stepping motor or spindle 102.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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Niesporek et al. (5,535,654), Hicks (5,119,759), Wikefedt et al. (3,845,659), Persson (5,609,083), Wells et al. (3,690,154), Tsukamoto (4,856,326), Dern (5,671,648), Leighton (5,282,404), Guenther et al. (6,634,268), and Gunther et al. (6,598,307) teach a method for cutting a specimen having a trimmed surface with a microtome.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ghassem Alie whose telephone number is (571) 272-4501.

The examiner can normally be reached on Mon-Fri 8:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan Shoap can be reached on (571) 272-4514. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, SEE <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (too-free).



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